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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,257	07/27/2001	Masayuki Hisatake	040894-5692	6806
9629 7590 05/31/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER MILIA, MARK R	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 05/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/915,257

Applicant(s)

HISATAKE ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 6 is/are allowed.
- 6) ☒ Claim(s) 2-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/07 has been entered. Currently, claims 1-9 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Application Publication No. 11-127297 to Tanimoto, as cited on Information Disclosure Statement dated July 27, 2001.

Regarding claim 2, Tanimoto discloses an image information processing apparatus adapted to generate image information having image data and attribute information pertaining to the image data in a image file format, wherein the image file format enables storage of the image data and the attribute information at arbitrary positions in the image file, comprising: a controller that generates the image information, wherein a plurality of image data and a plurality of attribute information are arranged in a predetermined sequence in the image file and further includes, a first information in a header information and a second information in a first image files directory of the image information, wherein the first and second information identifies the image files format of the image information as being in the predetermined sequence (see Drawings 1, 2, and 4, paragraphs [0004]-[0010], [0013], [0016], [0024], [0028] lines 3-6, [0030] lines 1-4, [0031] lines 1-3, [0034]-[0039], and [0049]-[0050], reference shows that documents are converted to TIFF and attached to an e-mail for transmission, wherein the TIFF files includes a header with first information and includes an image file directory that contains second information, the first and second information relating to the predefined sequence of the TIFF file) and an output unit that outputs the generated image information (see Drawing 1 and 4 and paragraphs [0004]-[0010] and [0020] lines 2-5).

Regarding claim 7, Tanimoto discloses a computer-readable storage medium that stores a program for causing a computer to perform processes for producing image

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information, the processes comprising: generating the image information having image data and attribute information pertaining to the image data in an image file format, wherein the image file enables storage of the image data and the attribute information at arbitrary positions in the image file (see Drawings 1, 2, and 4, paragraphs [0013], [0016], [0024], [0028] lines 3-6, [0030] lines 1-4, [0031] lines 1-3, [0034]-[0038], and [0049]-[0050]), storing a first information in a header information and a second information in a first image file directory of the image information, wherein the first and second information indicates that a plurality of attribute information and a plurality of image data included in the image information are arranged in a predetermined sequence (see Drawing 4 and paragraphs [0004]-[0010], [0016], [0024], and [0034]-[0039]), and outputting the produced image information (see paragraphs [0020] lines 2-5 and [0038]).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto in view of U.S. Patent No. 6,128,101 to Saito.

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Regarding claim 4, Tanimoto discloses an image information processing apparatus adapted to receive image information having image data and attribute information pertaining to the image data in a image file format, wherein the image file format enables storage of the image data and the attribute information at arbitrary positions in the image file comprising: a controller that immediately begins decompressing the image data when the received information based on the exchange indicates that a plurality of attribute information and a plurality of image data included in the image information are arranged in the predetermined sequence (see paragraphs [0004]-[0010], [0016], [0030] lines 1-4, [0031] lines 1-3], and [0034]-[0039]).

Tanimoto does not disclose expressly a communication unit that exchanges, with a sender device externally connected via a network, negotiation information in connection with a layout sequence of the image data and attribute the information and that receives a information based on a result of the exchange and the image information, wherein the information is received prior to the image information and the information specifies the image file of the image information as being in a predetermined sequence.

Saito discloses a communication unit that exchanges, with a sender device externally connected via a network, negotiation information in connection with a layout sequence of the image data and attribute the information and that receives a information based on a result of the exchange and the image information, wherein the information is received prior to the image information and the information specifies the

image file of the image information as being in a predetermined sequence (see column 3 line 38-column 4 line 5 and column 5 lines 12-67).

Regarding claim 5, Tanimoto discloses an image information processing apparatus adapted to generate image information having image data and attribute information pertaining to the image data in a image file format, wherein the image file format enables storage of the image data and the attribute information at arbitrary positions in the image file comprising: a controller that generates the image information, wherein a plurality of image data and a plurality of attribute information are arranged in a predetermined sequence in the image file (see Drawings 1, 2, and 4, paragraphs [0004]-[0010], [0013], [0016], [0024], [0028] lines 3-6, [0030] lines 1-4, [0031] lines 1-3], [0034]-[0038], and [0049]-[0050]), a communication unit that exchanges, with a receiver device externally connected via a network and is to send image information, and that transmits the generated image information (see Drawings 1, 2, and 4, paragraphs [0004]-[0010], [0013], [0016], [0024], [0028] lines 3-6, [0030] lines 1-4, [0031] lines 1-3], [0034]-[0039], and [0049]-[0050]).

Tanimoto does not disclose expressly wherein negotiation information is in connection with a layout sequence of the image data and the attribute information, wherein prior to transmitting the image information, the communication unit outputs a information based on a result of the exchange specifying the image file format of the image information as being in the predetermined sequence.

Saito discloses a communication unit that exchanges, with a receiver device externally connected via a network and is to send image information, negotiation

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information in connection with a layout sequence of the image data and the attribute information and that transmits the generated image information, wherein prior to transmitting the image information, the communication unit outputs a information based on a result of the exchange specifying the image file format of the image information as being in the predetermined sequence (see column 3 line 38-column 4 line 5 and column 5 lines 12-67).

Regarding claim 8, Tanimoto discloses a computer-readable storage medium that stores a program for causing a computer to perform processes for entering and decompressing image information, the processes comprising: receiving the image information having image data and attribute information pertaining to the image data in an image file format, wherein the image file enables storage of the image data and the attribute information at arbitrary positions in the image file (see Drawings 1, 2, and 4 and paragraphs [0004]-[0010], [0013], [0016], and [0018]), receiving the image information (see paragraphs [0034]-[0039]), and decompressing the image data included in the received image information (see paragraphs [0030] lines 1-4 and [0031] lines 1-3).

Tanimoto does not disclose expressly conducting negotiations with a sender device externally connected via network in connection with a layout sequence of the image data and the attribute information and receiving a information based on a result of the exchange, wherein the information specifies the image file format of the image information as being in a predetermined sequence.



Saito discloses conducting negotiations with a sender device externally connected via network in connection with a layout sequence of the image data and the attribute information and receiving a information based on a result of the exchange, wherein the information specifies the image file format of the image information as being in a predetermined sequence (see column 3 line 38-column 4 line 5 and column 5 lines 12-67).

Regarding claim 9, Tanimoto disclose a computer-readable storage medium that stores a program for causing a computer to perform processing for producing image information, the processes comprising: generating the image information having image data and attribute information pertaining to the image data in an image file format, the image file enables storage of the image data and the attribute information at arbitrary positions in the image file, wherein a plurality of image data and a plurality of attribute information are arranged in a predetermined sequence in the image file (see Drawings 1, 2, and 4 and paragraphs [0004]-[0010], [0013], [0016], and [0018]) and transmitting the produced image information (see paragraphs [0034]-[0039]).

Tanimoto does not disclose expressly conducting negotiations with a receiver device externally connected via network in connection with a layout sequence of image data and attribute information pertaining to the image information to be output and outputting a information based on a result of the exchange specifying the image file format of the image information as being in the predetermined sequence.

Saito discloses conducting negotiations with a receiver device externally connected via network in connection with a layout sequence of image data and attribute

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information pertaining to the image information to be output and outputting a information based on a result of the exchange specifying the image file format of the image information as being in the predetermined sequence (see column 3 line 38-column 4 line 5 and column 5 lines 12-67).

Tanimoto & Saito are combinable because they are from the same field of endeavor, transmission and reception of TIFF files and analysis to determine acceptability of the TIFF files based on TIFF file information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the analyzing of TIFF file information, prior to receiving image information included in the TIFF file, as described by Saito, with the system of Tanimoto.

The suggestion/motivation for doing so would have been to decrease the amount of memory needed to store file attachments and prevent reception of image files that can not be processed by the system (see column 1 lines 11-40 of Saito).

Therefore, it would have been obvious to combine Saito with Tanimoto to obtain the invention as specified in claims 4, 5, 8, and 9.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto as applied to claim 2 above, and further in view of Saito.

Tanimoto does not disclose expressly wherein said output unit exchanges negotiation information in connection with a layout sequence of the attribute information and the image data with a receiver device which receives the image information, and

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said controller generates a information specifying the image file format of the image information on the basis of a result of the exchanged negotiation information.

Saito discloses wherein said output unit exchanges negotiation information in connection with a layout sequence of the attribute information and the image data with a receiver device which receives the image information, and said controller generates a information specifying the image file format of the image information on the basis of a result of the exchanged negotiation information (see column 3 line 38-column 4 line 5 and column 5 lines 12-67).

Tanimoto & Saito are combinable because they are from the same field of endeavor, transmission and reception of TIFF files and analysis to determine acceptability of the TIFF files based on TIFF file information.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the analyzing of TIFF file information, prior to receiving image information included in the TIFF file, as described by Saito, with the system of Tanimoto.

The suggestion/motivation for doing so would have been to decrease the amount of memory needed to store file attachments and prevent reception of image files that can not be processed by the system (see column 1 lines 11-40 of Saito).

Therefore, it would have been obvious to combine Saito with Tanimoto to obtain the invention as specified in claim 3.

***Allowable Subject Matter***

8. Claims 1 and 6 are allowed.
9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose, teach, or suggest the claimed limitations of (in combination with all other limitations in the claims), a controller that determines whether a plurality of image data and a plurality of attribute information included in the image information are arranged in a predetermined sequence based on whether an offset value of an image file directory included in a header information of the image information is a predetermined value and whether a character sequence specified by a software tag filed included in the image file directory matches a predetermined character sequence, and decompresses the image data when the image data and the attribute information are determined to be arranged in the predetermined sequence, as set forth in claim(s) 1 and 6.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

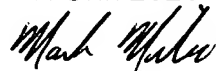
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

Mark R. Milia  
Examiner  
Art Unit 2625



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER